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EXAMINER

BOVEJA, NAMRATA

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3622

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Please find below and/or attached an Office communication concerning this application or proceeding.



### DETAILED ACTION

1. Claims 1-28 are presented for examination.

#### **Claim Rejections - 35 USC § 112**

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, claim 15 recites "units of systems." It is not defined in the specification what is the meaning of said "units of systems." It is interpreted to mean that units of systems refer to bookmarks associated with a computer, which can also be associated with a user of the computer. Appropriate correction is required.

4. The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

- (A) the claims must set forth the subject matter that applicants regard as their invention; and
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

5. Claims 19, 22, and 25, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

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which applicant regards as the invention. Claims 19, 22, and 25 specifically recite "the service provided to the buyer is to partially repay the buyer a presentation charge paid to the presenter specified by the link information." It is unclear why a presenter who is referring a buyer to a seller would repay the buyer a presentation charge unless the presenter and the seller are the same entities. Otherwise, the presenter would want to receive a referral payment for bringing the buyer to the seller's website. This is interpreted to mean that the buyer receives a discount on the purchase of a product or service. Clarification is required.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 4-7, 9, 17-19, and 23-25 are rejected under 102(b) as being anticipated by the recommend-it.com website from May 30, 1998 ([webarchive.org/web/19980610011812/recommend-it.com/html/sample.html](http://webarchive.org/web/19980610011812/recommend-it.com/html/sample.html)), hereinafter recommend-it.com.

In reference to claims 1, 17, and 23, recommend-it.com discloses an advertisement method and system of providing an advertisement of merchandise to be sold on the Internet, comprising: the first step of designating to transmit, by an e-mail message, information related to the piece of merchandise of the advertisement displayed on a display device usable by a number of users (page 1 lines 18-22, page 2

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lines 1-13 of the left frame and lines 1-8 of the form, and page 4 lines 1-17); the second step of designating a recipient of the e-mail message for which transmission is designated in the first step (page 2 lines 4 and 5 of the form and page 4 line 2); the third step of, when transmission of the e-mail message is designated in the first step, transmitting the e-mail message having the information of the piece of merchandise (page 2 lines 8 and page 4 lines 1-17), including link information linked with a site on the Internet where the piece of merchandise is on sale, (page 4 lines 7-10) to the recipient designated in the second step, the link information containing information representing a presenter of the piece of merchandise (page 4 lines 7-17); and the fourth step of, when the piece of merchandise is purchased at the site on the Internet by the e-mail message transmitted in the third step, specifying the presenter by the link information and providing a service corresponding to a payable amount for the piece of merchandise to a buyer (page 4 lines 7-17) (i.e. in this case, the service provided is the WebDeck Software using which on-line card games can be played, and this service is provided for a charge of \$0 in this specific case, but the amount payable is arbitrary and can vary from one ad to the next for different products).

7. In reference to claim 2, recommend-it.com teaches an advertisement system wherein said system further comprises a connection device connected to a network (i.e. Internet access is required for sending an e-mail) (page 2 lines 1-8 of form, page 4 lines 1-17), and said mail transmission device has a function of connecting to the network and transmits the e-mail message having the information of the piece of merchandise (page 2 lines 1, 7, and 8 of the form and page 4 lines 1-17), including the link

information linked with the site on the Internet where the piece of merchandise is on sale (page 4 lines 7-10), to a mail address on the network (page 2 lines 1-35 of the side bar and lines 4 of the form and page 4 line 2), which is input by said input device (page 2 lines 20-35 of the side bar and lines 2-7 of the form).

8. In reference to claim 4, recommend-it.com teaches an advertisement system wherein said system comprises a memory in which an address capable of receiving an e-mail message is registered in advance for each user (i.e. registered users have access to this service) (page 2, lines 28-40 of the left frame), and said input device causes a user to select an address to which the e-mail message is to be transmitted from a list of users registered in said memory in advance (i.e. group and last five features) (page 2, lines 28-35 of the left frame).

9. In reference to claim 5, recommend-it.com teaches an advertisement system wherein said system comprises a memory for storing, as a transmission log, an address for an e-mail message transmitted by said mail transmission device (page 2, lines 28-40 of the left frame), and said input device causes a user to select an address to which the e-mail message is to be transmitted from a list of transmission logs registered in said memory (i.e. last five features) (page 2, lines 28-35 of the left frame).

10. In reference to claim 6, recommend-it.com teaches an advertisement system wherein said system comprises a memory for storing a plurality of types of forms (i.e. a different form for each website that is recommended customized with the URL of that website) (page 2 line 1 of the form) of an e-mail message to be transmitted by said mail transmission device, said input device causes a user to select a form (i.e. for the

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website the user wants to recommend) of the e-mail message to be transmitted from the forms stored in said memory (page 2 lines 1-8 of the form), and said mail transmission device generates the e-mail message having the information of the piece of merchandise including the link information linked with the site on the Internet where the piece of merchandise is on sale (page 4 lines 7-17), using the form selected by said input device and transmits the e-mail message (page 2 lines 1-8 of the form and the Recommend-It!! button on line 8 of the form).

11. In reference to claim 7, recommend-it.com teaches an advertisement system wherein said memory stores at least a form for requesting a buyer (i.e. the user can also be the buyer) who has an authority for purchase to purchase the piece of merchandise as one of the forms, and when the form for requesting purchase of the piece of merchandise is selected by said input device (page 2 lines 1-8 of the form), said mail transmission device transmits the e-mail message (page 2 line 8 of the form and the button Recommend-It!! in the form) having the information of the piece of merchandise (page 4 lines 7-17) wherein said memory stores at least a form for requesting a buyer who has an authority for purchase to purchase the piece of merchandise as one of the forms, and when the form for requesting purchase of the piece of merchandise is selected by said input device (page 2 line 8 of the form and the button Recommend-It!! in the form), said mail transmission device transmits the e-mail message having the information of the piece of merchandise (page 4 lines 7-17).

12. In reference to claim 9, recommend-it.com teaches an advertisement system wherein the link information contains information representing a presenter of the piece of merchandise (i.e. the advertiser) (page 4 lines 7-17).

13. In reference to claims 18, 19, 24, and 25, recommend-it.com teaches an advertisement method wherein the service provided to the buyer is discount or cash back of an amount corresponding to the payable amount (i.e. the user can get the software for zero dollars or free) (page 4 lines 7-17) and to partially repay the buyer a presentation charge paid to the presenter specified by the link information (i.e. give a specified discount based on the sponsor of the link) (page 4 lines 7-17).

14. Claims 10-12, 15, and 16 are rejected under 102(b) as being anticipated by the America Online Tour Guide Version 3 published in 1996 hereinafter AOL guide.

In reference to claim 10, the AOL guide teaches an advertisement system which provides an advertisement of merchandise to a number of users, comprising: a display device for displaying the advertisement of merchandise (page 79 Figure 3-11) (i.e. e-mail viewable on a monitor); a memory for storing, as a bookmark, information related to the piece of merchandise displayed by said device (page 78 lines 8-14, page 127 lines 23 to page 129 lines 3, and Figure 4-7) (i.e. the heart icon bookmarks a favorite page and stores it in a browser); a registration button (i.e. the heart icon) for registering the information related to the piece of merchandise as the bookmark when the advertisement of the piece of merchandise is being displayed on said device (page 78 lines 8-14, page 127 lines 23 to page 129 lines 3, and Figure 4-7) (i.e. the AOL guide is generic regarding the content of the websites that are bookmarked and includes



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websites that can have advertisements on them as well); and a server device for, upon being accessed from an external device, transmitting the information related to the piece of merchandise registered in said memory as the bookmark to the external device as data displayable on the external device, the data displayable on the external device containing link information linked with a site on the Internet where the piece of merchandise is on sale (i.e. add the heart icon for a favorite site link to an e-mail message) (page 78 lines 1-17).

15. In reference to claim 11, the AOL guide teaches a link that contains information representing a presenter of the piece of merchandise (i.e. the advertiser) (page 78 lines 1-17).

16. In reference to claim 12, the AOL guide teaches an advertisement system wherein said server device has a function of connecting to a network and is accessed from the external device through the network (i.e. Internet access is required to send e-mail messages and links) (page 78 lines 1-17 and Figure 3-11).

17. In reference to claims 15 and 16, the AOL guide teaches an advertisement system wherein said memory stores the information related to the piece of merchandise as the bookmark in units of systems (i.e. bookmarks associated with a computer which can also be associated with a user) and units of users (i.e. bookmarks associated with a particular user), and for a user who has accessed said server by the external device (i.e. the user logs in and can view his bookmarks and can send these bookmarks to others) (page 78 lines 8-14), said server transmits the information related to the piece of merchandise registered as the bookmark corresponding to said system to the external

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device as the data displayable on the external device (i.e. an e-mail with a hyperlink) (page 78 lines 8-14 and Figure 4-7).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 3 and 8 are rejected under U.S.C. 103(a) as being unpatentable over recommend-it.com in view of Official Notice.

In reference to claims 3, recommend-it.com teaches an advertisement system that transmits the e-mail message having the information of the piece of merchandise (page 2 lines 1-13 of the left frame and lines 1, 7, and 8 of the form and page 4 lines 1-17), including the link information linked with the site on the Internet where the piece of merchandise is on sale (page 4 lines 7-10). Recommend-it.com does not teach the system wherein said mail transmission device is a radio communication module for performing short-distance radio communication and connects to a portable terminal designated by said input device and connectable by short-distance radio communication to and where the link information is sent to the portable terminal.

Official Notice is taken that it is old and well known for a system to include a radio communication module, since this enables users to communicate wirelessly via a cell phone for example. Official Notice is also taken that is old and well known for a system

to include sending link information to a portable terminal when the user is using a hand-held device such as a PDA to access information provided online by the WWW server. Furthermore, some type of an Internet connection and a device is required to carry out the recommend-it.com service online. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include a radio communication device such as a cell phone connected to a network such as the Internet and the WWW server to enable users to utilize the service of recommending websites as provided by companies such as recommend-it.com wirelessly.

19. In reference to claim 8, recommend-it.com teaches an advertisement system wherein said display of the advertisement displayed on said device is set in accordance with a category of the piece of advertised merchandise (i.e. an advertisement for the category of software is displayed) (page 4 lines 7-17). Recommend-it.com does not teach an advertisement system that further comprises a memory and said device that displays the advertisement of the piece of merchandise on the basis of the permission/inhibition of display set in said memory.

Official Notice is taken that is old and well known for a system to include the permission/inhibition of display of the advertisement for the piece of merchandise on the basis of permission/inhibition of the display set in said memory displayed on said device as done in the case of electronic coupons for retailers online where the coupons are displayed for a specific time frame or for specific items (i.e. must be used on that day's, on a current purchase of a specific item, or within a certain timeframe). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's

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invention to include the permission/inhibition of display of the advertisement for the piece of merchandise on the basis of permission/inhibition of the display set in said memory displayed on said device as done in the case of electronic coupons for retailers online where the coupons are displayed for a specific time frame or for specific items to motivate customers to make purchases for specific items (i.e. the manufacturer has extra inventory) or within a specific time frame (i.e. a retailer is offering a holiday sales promotion).

20. Claims 13 and 14 are rejected under U.S.C. 103(a) as being unpatentable over the AOL guide in view of Official Notice.

In reference to claims 13 and 14, the AOL guide teaches an advertisement system that transmits the e-mail message having the information of the piece of merchandise, including the link information linked with the site on the Internet where the piece of merchandise is on sale (page 78 lines 8-14 and Figure 4-7). The AOL Guide does not teach the system wherein said mail transmission device is a radio communication module for performing short-distance radio communication and connects to a portable terminal designated by said input device and connectable by short-distance radio communication to and where the link information is sent to the portable terminal.

Official Notice is taken that it is old and well known for a system to include a radio communication module, since this enables users to communicate wirelessly via a cell phone for example. Official Notice is also taken that is old and well known for a system to include sending link information to a portable terminal when the user is using a hand-

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held device such as a PDA to access information provided online by the WWW server. Furthermore, some type of an Internet connection and a device is required to carry out the AOL e-mail and bookmark service online. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include a radio communication device such as a cell phone connected to a network such as the Internet and the WWW server to enable users to utilize the service of recommending websites as provided by companies such as AOL wirelessly.

21. Claims 20-22 and 26-28 are rejected under U.S.C. 103(a) as being unpatentable over the AOL guide in view of the article titled "Citibank Launches ClickCredit (SM): A Powerful New Online Shopping Tool for Consumers" from PR Newswire dated October 27, 1999 hereinafter Citibank article.

In reference to claims 20 and 26, the AOL guide teaches an advertisement method and system of providing an advertisement of merchandise provides an advertisement of merchandise to be sold on the Internet, comprising: the first step of storing, as a bookmark, information related to the piece of merchandise displayed on a device usable by a number of users in a memory (page 78 lines 8-14, page 127 lines 23 to page 129 lines 3, and Figure 4-7) (i.e. the heart icon bookmarks a favorite page and stores it in a browser); the second step of, in accordance with an access from an external device, transmitting the information related to the piece of merchandise registered in the memory as the bookmark in the first step to the external device as data displayable on the external device (i.e. add the heart icon for a favorite site link to an e-mail message) (page 78 lines 1-17), the data displayable on the external device

containing link information linked with a site on the Internet where the piece of merchandise is on sale, and the link information containing information representing a presenter of the piece of merchandise (i.e. the AOL guide is generic regarding the content of the websites that are bookmarked and includes websites that can have advertisements on them as well) (page 78 lines 1-17).

The AOL Guide is silent about the third step of, when the piece of merchandise is purchased at the site on the Internet linked by the link information of the bookmark displayed on the external device by the data transmitted in the second step, providing a service corresponding to a payable amount for the piece of merchandise to a buyer (i.e. giving an incentive to the user for buying products online via a link). The Citibank article teaches giving an incentive to the user for buying products online via a link to CitiPlaza from the Citibank Cards web site (page 2 lines 20-23 and 30-34).

It would have been obvious to the AOL guide to include a method and system of providing a service corresponding to a payable amount for the piece of merchandise to a buyer to encourage users to make purchases via the online links and to increase customer loyalty by offering rewards for aggregate amounts of purchases that thereby bring customers back to the sites to make greater purchases to receive bigger rewards.

22. In reference to claims 21, 22, 27, and 28, the AOL guide does not teach an advertisement system wherein the service provided to the buyer is discount or cash back of an amount corresponding to the payable amount (i.e. giving an incentive to the user for buying products online via a link) and specified by the link information. The Citibank article teaches giving an incentive to the user for buying products online via a

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link to CitiPlaza from the Citibank Cards web site (page 2 lines 20-23 and 30-34) wherein the incentives are specified by link information such as double mileage with American Airlines or 2% cash back for Citi Platinum Select members for a limited time period (page 2 lines 20-23).

It would have been obvious for the AOL guide to include a method and system of providing a service corresponding to a payable amount for the piece of merchandise to a buyer to encourage users to make purchases via the online links and to increase customer loyalty by offering rewards for aggregate amounts of purchases that thereby bring customers back to the sites to make greater purchases to receive bigger rewards. It would have also been obvious for the AOL guide to include specifying different incentives from the link information when sponsors want to offer different or multiple incentive opportunities such as miles and cash back.

### **Conclusion**

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

- a) Ingram Patent Number 6,925,496. Teaches a method of enhancing hyperlinks by and displaying a link snapshot based on the hyperlink.
- b) Rice Patent Number 6,486,891. Teaches a method of automated bookmarking of online advertisements. Teaches a system and method for influencing a position on a search result list generated by a computer network search engine.

Any inquiry concerning this communication or earlier communications from

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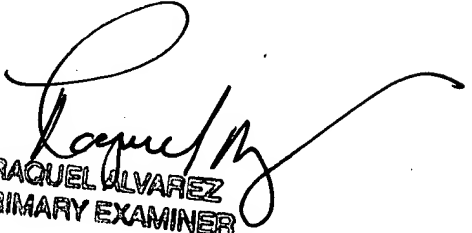
the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. On July 15, 2005, the Central FAX Number changed to **571-273-8300**. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

November 28<sup>th</sup>, 2005

  
RAQUEL ALVAREZ  
PRIMARY EXAMINER